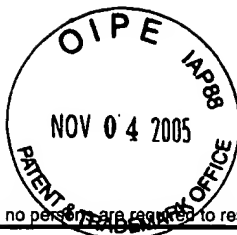


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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# PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

8,230.62453

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on November 2, 2005

Signature Vivian DeLaRosa

Typed or printed name VIVIAN DELA ROSA

Application Number

09/905,432

Filed

7/13/01

First Named Inventor

PATRICK H. HAYES

Art Unit

2614

Examiner

NATNAEL, PAULOS M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record. 35,906  
Registration number

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34

Signature

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Telephone number

November 2, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## REASONS FOR REQUEST

In the application claims 1-7, 16-20, 22-27, 29, 32 and 33 remain pending. Claims 1-7, 16-18, 23-25, 32, and 33 stand rejected. Claims 19, 20, 22, 26, 27, and 29 have been indicated to contain allowable subject matter.

Claims 1-4, 16-18, 23-25, 32, and 33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Allport (U.S. Patent No. 6,567,984).

It is respectfully requested that the rejection based upon Allport be withdrawn for the reason that Allport does not disclose, teach, or suggest each and every element set forth in the claims as is required to maintain a rejection under 35 U.S.C. § 102, i.e., "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As set forth in the response filed on September 15, 2005, nowhere does Allport disclose, teach, or suggest that closed captioning information is read from a video signal with the closed captioning information read from the video signal *then being loaded into a pre-formatted markup language page* that is downloadable to a hand-held device. In Allport, HTML pages are embedded within a VBI (vertical blanking interval) and a base station (75) having an HTML parser does nothing more than pass the received HTML pages through to a remote control with, at best, some parts of the HTML pages being stripped from the HTML pages (i.e., parsed) prior to the HTML pages being passed through to the remote control. Thus, by disclosing a system in which received HTML pages are merely passed through to a remote control, it is evident that Allport cannot be said to disclose, teach, or suggest a system in which closed captioning information, i.e., non-html formatted data, is read from a video signal *followed by the*

*information read from the video signal being loaded into a pre-formatted mark-up language page* for downloading to a hand-held device as is claimed.

That Allport fails to disclose, teach, or suggest at least the claimed loading of closed captioning information read from a video signal *into a pre-formatted mark-up language page* for downloading to a hand-held device is evidenced by the fact that the rejection of the claims never cites to any passage from Allport wherein these claimed elements may be found. In particular, the Examiner has continued to ignore the numerous requests that a passage within Allport be cited that may be said to disclose loading read information into a pre-formatted mark-up language page for downloading to a hand-held device. Despite these numerous requests, the Examiner continues to ignore these claimed elements in the rejection of the claims and instead impermissibly distills the claimed invention down to its “gist” or “thrust” for the purpose of demonstrating the alleged anticipation of the claims. For example, in the Advisory Action of October 28, 2005 it is never asserted that Allport discloses loading information read from a video signal into a pre-formatted mark-up language page for downloading to a hand-held device. Rather, the Advisory Action of October 28, 2005 alleges that Allport anticipates the claimed invention for the mere reason that Allport “discloses HTML software would be used to display the data on the remote control’s display.” While Allport may disclose displaying HTML data on a remote control as asserted by the Examiner, it is again submitted that the disclosed system of Allport only functions to pass received HTML pages to the remote control for display as opposed to reading closed-captioning information from a video signal and then loading the read information into a pre-formatted HTML page for downloading to a hand-held device as is claimed.

In sum, since the rejection of the claims fails to allege that Allport discloses (or cite to any passages within Allport where Allport can be said to disclose) the claimed elements of

reading from a video signal closed captioning information and *loading the closed captioning information read from the video signal into a pre-formatted mark-up language page* for downloading to a hand-held device and since a careful review of Allport evidences that this omission arises from the fact that Allport simply fails to disclose, teach, or suggest at least these claimed elements, it is respectfully submitted that claims 1-4, 16-18, 23-25, 32, and 33 should be deemed to be allowable.

Claims 5 and 6 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Liu (U.S. Patent No. 5,953,005). It is respectfully requested that the rejection based upon Liu be withdrawn for the reason that Liu does not disclose, teach, or suggest each and every element set forth in the claims as is required to maintain a rejection under 35 U.S.C. § 102, i.e., “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As set forth in the response filed on September 15, 2005, nowhere does Liu disclose, teach, or suggest that song lyrics or movie sub-titles are read from a recorded media with the song lyrics or movie sub-titles read from the recorded media *then being loaded into a pre-formatted mark-up language page* that is downloadable to a hand-held device as is claimed. Rather, Liu expressly states that the system does nothing more than pass through to device, e.g., a user’s computer or a PDA, content that is retrieved from a remote server (Col. 3, lines 24-64). Thus, in Liu, there is no extracting of information from a recorded media *followed by the information extracted from the recorded media being loaded into a pre-formatted mark-up language page* for downloading to a hand-held device as is claimed.

That Liu fails to disclose, teach, or suggest at least the claimed loading of information read from a recorded media *into a pre-formatted mark-up language page* for downloading to a hand-held device is evidenced by the fact that the rejection of the claims never cites to any

passage from Liu wherein these claimed elements may be found. In particular, the Examiner has continued to ignore the numerous requests that a passage within Liu be cited that may be said to disclose loading read information into a pre-formatted mark-up language page for downloading to a hand-held device. Despite these numerous requests, the Examiner continues to ignore these claimed elements in the rejection of the claims and instead impermissibly distills the claimed invention down to its “gist” or “thrust” for the purpose of demonstrating the alleged anticipation of the claims. For example, in the Advisory Action of October 28, 2005 it is never asserted that Liu discloses loading information read from a recorded media into a pre-formatted mark-up language page for downloading to a hand-held device. Rather, the Advisory Action of October 28, 2005 alleges that Liu anticipates the claimed invention for the mere reason that Liu “teaches that in a Karaoke application, a user may access songs and the accessed data may be downloaded to the user computer system which may include a PDA.” While Liu may disclose downloading song lyrics to a PDA as asserted by the Examiner, it is again submitted that the disclosed system of Liu only functions to pass through to the PDA the song lyrics received from a remote server as opposed to reading song lyrics or movie captions from a recorded media and then loading the read information into a pre-formatted HTML page for downloading to a hand-held device as is claimed.

In sum, since the rejection of the claims fails to allege that Liu discloses (or cite to any passage from Liu where Liu can be said to disclose) the claimed elements of reading from a recorded media song lyrics or movie captions and *loading the information read from the recorded media into a pre-formatted mark-up language page* for downloading to a hand-held device and since a careful review of Liu evidences that this omission arises from the fact that Liu simply fails to disclose, teach, or suggest at least these claimed elements, it is respectfully submitted that claims 5 and 6 should be deemed to be allowable.

CONCLUSION

It is respectfully submitted that the application is in good and proper form for allowance. The Commissioner is authorized to charge any fee deficiency or credit overpayment to deposit account 50-2428 in the name of Greenberg Traurig.

Respectfully Submitted,

A handwritten signature in black ink, appearing to be 'G. Jarosik', written over a horizontal line.

Date: November 2, 2005

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